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EXAMINER

LIANG, VEI CHUNG

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/541,798 | Applicant(s) SONG ET AL. | |
| | Examiner VEI-CHUNG LIANG | Art Unit 2165 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 10, 2008 has been entered.

Status of Claims

Claims 1-22 are pending, of which **Claims 1, 16, and 22** are in independent form.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 - 19, and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per Claim 1, 16, and 22, claims 1, 16, and 22 recite an amended limitation of **“by providing a plurality of professional scheme models at an enterprise view, a business unit view, a division view, departmental view, team view and an individual view”** which was not described in the originally filed disclosure.

The Applicant pointed the support of the amendment to paragraph 0028 and Figure 6. However, Paragraph 0028 of the specification discloses business unit COTA shell, division COTA shell, departmental COTA shell, team COTA shell and personal COTA shell. There is no support in the specification to equate a shell to a view. A shell is defined as a piece of software, usually a separate program, that provides direct communication between the user and the operating system and a view is defined as the display of data or an image from a given perspective or location (Microsoft computer dictionary, fifth edition, May 2002). One skilled in the relevant art is not reasonably conveyed that the inventor(s), at the time the application was filed had possession of the claimed invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claim 21, Claim 21 recites the limitation "their employee" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1 – 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per Claim 1, 16, and 22, Claims 1, 16, and 22 are directed to a system comprising data, receivers, a data store, and an interface, which are directed to software (Figure 3 and paragraph 0019). A software is not directed to a machine within the meaning of 101, since it is not a part of a device or a combination of devices. A software is not directed to a Manufacture within the meaning of 101, since it is not an article produced from raw or prepared materials. A software is not a composition of matter within the meaning of 35 U.S.C. 101, since it is not a combination of two or more substances nor does it have any mass to be matter. Therefore, it is non-statutory under 35 U.S.C. § 101.

The dependent claims, claims 2 – 15, and 17 - 21, included in the statement of reject but not specifically addressed in the body of the rejection have inherited the deficiencies of their parent claim and have not resolved the deficiencies. Therefore, they are rejected based on the same rationale as applied to their parent claim above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 – 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman et al. US 6,711,585 B1 (hereinafter referred as Copperman) in view of Szabo US 7,181,438 B1 (hereinafter referred as Szabo).

As per Claim 1, Copperman teaches:

A system for storing knowledge, information and data (KID), (Copperman, column 5, lines 8 – 9, e.g. the present invention stores the individual instance of information) **comprising:**

a plurality of sources of KID (Copperman, column 5, lines 10 - 11, e.g. concepts that can be associated with multiple instances);

a plurality of receivers of KID from said plurality of sources (Copperman, column 5, lines 14 – 15, e.g. knowledge containers);

a universal knowledge, information and data store (UKIDS) (Copperman, column 6, line 50, a knowledge domain); **and**

an interface coupling said receivers and said UKIDS (Copperman, column 6, lines 46 – 50, e.g. context tags or taxonomy tags represent multidimensional classification of the knowledge container against a knowledge map. Such classification puts the knowledge container in context within a knowledge domain),

said interface providing a plurality of logical partitions for segregating and storing said KID in a priority-based and standardized scheme within said UKIDS (Copperman, column 6, lines 52 - 54, e.g. each taxonomy tag includes the name or other unique identifier of a concept node within a taxonomy followed by a number which indicates the knowledge container's strength of association with that concept node),

wherein said priority based scheme reflects personal and professional core values of a free enterprise economic system (Copperman, column 8, lines 20 - 22, e.g. taxonomy tags are grouped by taxonomy and then ordered by weight), **and**

wherein said standardized scheme includes a clustering of KID (Copperman, column 6, lines 46 – 47, e.g. context tags or taxonomy tags represent a multidimensional classification)

to promote transferability between said receivers, extensibility across data store platforms and scalability in understanding of said KID by each of said receivers (The Examiner reminds the Applicant that the limitation of “to promote transferability, extensibility, and scalability” is not limiting the scope of the claim because such limitation is not further limiting the claim to a particular structure. SEE MPEP 2111.04),

by providing a plurality of professional scheme models (Copperman, column 5, lines 20, e.g. different types of knowledge container are used for different kinds of content and resources) **at an enterprise view** (Copperman, column 10, line 15, e.g. tag the knowledge container to IBM) **, a business unit view** (Copperman, column 14, lines 33 – 36, .e.g the following entity types are examined: organization), **a division view,**

departmental view (Copperman, column 20, line 52, e.g. (tag taxo=government-agencies), **team view** (Copperman, column 38, lines 55 – 57, e.g. the user may be able to indicate that their question is about only “team sports”) **and an individual view** (Copperman, column 8, lines 58 – 59, e.g. customer knowledge container),

said interface further providing rules and tools for configuring said UKIDS and for storing and accessing KID included therein (Copperman, column 16, lines 1 – 2, a set of transformational inference rules can be applied to refine the taxonomy tags);

wherein said rules define methods for allocating KID within one of said plurality of logical partitions (Copperman, column 16, line 7, e.g. add new taxonomy tags to the content),

for purging KID from said UKIDS (Copperman, column 16, lines 6-7, e.g. remove taxonomy tag), **and**

for efficiently sharing and distributing KID between said receivers (Copperman, column 16, lines 17 – 18, e.g. if document is tagged to more than two children of a parent, add a tag to the parent);

wherein said tools include features and functions for presenting news and advertising of interest to said receivers (Copperman, column 52 - 54, e.g. the system is also capable of using customer profile information described above to push content to interested users),

for identifying targeted storage locations within specific ones of said plurality of logical partitions (Copperman, column 6, lines 18 – 23, e.g. hold a description of and a link to an electronic resources),

However, Copperman does not explicitly teach the limitation of:

for backup and archiving KID and for securing KID in said UKIDS; and wherein a first level of said logical partitions segregates KID storage into personal and professional levels, wherein a plurality of second personal levels under said first personal level segregates KID storage into a TEAMS OF PEOPLE subset, an ACTIVITIES subset and an ORGANIZATION AND ADMINISTRATION subset, and wherein a plurality of second professional levels under said first professional level and said plurality of professional scheme models segregates KID storage into categories of said free enterprise economic system including a CLIENTS subset, an OUTPUT subset, a TEAMS subset and an ADMINISTRATION subset.

On the other hand, Szabo teaches:

for backup and archiving KID (Szabo, column 82, lines 8 – 25, e.g. providing backup maps) **and for securing KID in said UKIDS** (Szabo, column 16, lines 10 – 11. e.g. the fields may include the user's name and a password); **and**

wherein a first level of said logical partitions segregates KID storage into personal and professional levels (Szabo, Figure 8, e.g. my favorites contains a partition of personal and professional),

wherein a plurality of second personal levels under said first personal level segregates KID storage into a TEAMS OF PEOPLE subset (Szabo, Figure 13, e.g. Possible user reorganization into family, friends, and colleagues), **an ACTIVITIES subset** (Szabo, Figure 12, e.g. My E-mail includes commercial and church) **and an ORGANIZATION AND ADMINISTRATION subset** (Szabo, Figure 12, e.g. My E-mail includes commercial and church) **subset, and**

wherein a plurality of second professional levels under said first professional level and said plurality of professional scheme models segregates KID storage into categories of said free enterprise economic system including a CLIENTS subset, an OUTPUT subset, a TEAMS subset and an ADMINISTRATION subset (Szabo, Figure 14, e.g. Business A includes balance sheet, income statement, and capital account).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Copperman's invention to have a personal and professional organization with backup and security tools in view of Szabo. Doing so would provide advantages such as a means for effectively providing structured information presentation (Szabo, column 16, line 38).

As per Claim 2, and also applied to claim 1, the combination of Copperman and Szabo teaches:

wherein said TEAMS OF PEOPLE subset includes KID pertaining to family, friends, and other groups of person of interest to said receivers (Szabo, Figure 13, e.g. Possible user reorganization into family, friends, and colleagues) .

As per Claim 3, and also applied to Claim 1, the combination of Copperman and Szabo teaches:

wherein said ACTIVITIES subset includes KID pertaining to vacations, sports, entertainment, spirituality, hobbies, and other activities (Szabo, Figure 12, e.g. My E-mail includes commercial and church).

As per Claim 4, and also applied to Claim 1, the combination of Copperman and Szabo teaches:

wherein said ORGANIZATION AND ADMINISTRATION subset includes KID pertaining to home upkeep, bills and other financial concerns (Szabo, Figure 12, e.g. My E-mail includes commercial and church).

As per Claim 5, and also applied to Claim 1, the combination of Copperman and Szabo teaches:

wherein said CLIENTS subset includes KID pertaining to philosophical groups of internal and external clients, customers, patrons, client projects, markets, key vendors, and sales territories (Szabo, Figure 14, e.g. Business A includes balance sheet, income statement, and capital account).

As per Claim 6, and also applied to Claim 1, the combination of Copperman and Szabo teaches:

wherein said OUTPUT subset includes KID pertaining to products, services, value added products and services, and any of the aforementioned offered to clients (Szabo, Figure 14, e.g. Business A includes balance sheet, income statement, and capital account).

As per Claim 7, and also applied to Claim 1, the combination of Copperman and Szabo teaches:

wherein said TEAMS subset includes KID pertaining to partnerships, collaborations, and any grouping of individuals that provide output to clients (Szabo, Figure 14, e.g. Business A includes balance sheet, income statement, and capital account) .

As per Claim 8, and also applied to claim 1, the combination of Copperman and Szabo teaches:

wherein said ADMINISTRATION subset includes KID pertaining to an operation and coordination of a business, business services, work flow and personnel, and non-core job responsibility (Szabo, Figure 14, e.g. Business A includes balance sheet, income statement, and capital account).

As per Claim 9, and also applied to Claim 1, the combination of Copperman and Szabo teaches:

wherein said UKIDS spans a plurality of data storage platforms including electronic and hard-copy storage means (Copperman, column 5, lines 20 – 26, e.g. knowledge containers can represent both rich electronic content and other physical resources).

As per Claim 10, and also applied to Claim 9, the combination of Copperman and Szabo teaches:

wherein said electronic storage means includes computer hard drives, backup and recovery media and off-line storage media (Copperman, column 4, lines 20 – 25, e.g. the collection of data bits stored within computer memory and represent specific electrical or magnetic elements).

As per Claim 11, and also applied to claim 10, the combination of Copperman and Szabo teaches:

wherein said hard-copy storage means includes bookcases, filing cabinets and desk tops (Szabo, column 85, line 22, e.g. indexed hard copy).

As per Claim 12, and also applied to Claim 1, the combination of Copperman and Szabo teaches:

wherein said interface includes a graphical user interface that allows each of said receivers direct access to electronic stored KID within said logical partitions of said UKIDS and to launch one or more of said tools (Copperman, column 8, lines 1 – 6, e.g. the present system is capable of displaying taxonomy tags several different ways:...2) show taxonomy tags which match a customer's profile).

As per Claim 13, and also applied to Claim 1, the combination of Copperman and Szabo teaches:

wherein said interface allows each of said receivers to distribute KID to other of said receivers (Copperman, column 16, lines 17 – 18, e.g. if document is tagged more than two children of a parent tag, add a tag to the parent) **and to identify a targeted location for storing said KID within one of said plurality of logical partitions** (Copperman, column 6, lines 35 – 40, e.g. a uniform resource locator for reaching the original version of the content).

As per Claim 14, and also applied to Claim 13, the combination of Copperman and Szabo teaches:

wherein said targeted storage location is comprised of a path for manual storage of said distributed KID within said logical partitions (Copperman, column 6, lines 35 – 40, e.g. a uniform resource locator for reaching the original version of the content).

As per Claim 15, and also applied to Claim 13, the combination of Copperman and Szabo teaches:

wherein said targeted storage location is comprised of at least a partially automated one of said tools such that, upon request, said distributed KID is automatically stored in a specified one of said logical partitions (Copperman, column 6, lines 35 – 40, e.g. a uniform resource locator for reaching the original version of the content).

As per claim 16, Claim 16 is recited similar limitations as Claim 1. The limitations are substantially the same as **Claim 1**; therefore, the rejection of Claim 1 also applies to Claim 16.

As per Claim 17, and also applied to Claim 1, the combination of Copperman and Szabo teaches:

wherein said rules for allocating KID include using said priority based scheme of said plurality of logical partitions to break ties when KID could be placed in more than one level and subset within said levels (Copperman, column 8, lines 20 – 22, e.g. taxonomy tags are grouped by taxonomy and then ordered by weight).

As per Claim 18, and also applied to Claim 1, the combination of Copperman and Szabo teaches:

wherein said rules for allocating KID include:

eliminating software application default storage locations such that electronic KID is stored within one of said plurality of logical partitions

(Copperman, column 6, lines 15 – 23, e.g. holds a description of and a link to an electronic resource);

implementing one storage system spanning electronic and physical storage locations (Copperman, column 5, lines 20 – 26, e.g. knowledge containers can represent both rich electronic content and other physical resources);

using said priority based scheme of said plurality of logical partitions to break ties when KID could be placed in more than one level and subset within said levels (Copperman, column 8, lines 20 – 22, e.g. taxonomy tags are grouped by taxonomy and then ordered by weight);

using a general subset for storing KID that properly references more than one of subset of said logical partitions (Copperman, column 16, lines 17 – 18, e.g. if document is tagged to more than two children of a parent, add a tag to the parent);

labeling all KID so as to include at least a date and a title thereof
(Copperman, column 20, lines 40 – 60, e.g. title tag and day tag);

employing a numerical indication of priority within a subset label for a selected subset when said selected subset contains a relatively large number of KID subsets (Copperman, column 6, lines 51 – 55, e.g. a concept node withint a taxonomy followed by a number indicating the knowledge container's strength);

maximizing availability of icons representing subsets of said logical partitions to highlight pathways for locating KID (Copperman, column 8, lines 24 – 25, e.g. the highest weighted tag is associated with the taxonomy);

when options for searching one subset of said plurality of logical partitions exceeds a predetermined number of KID storage locations, re-organizing said subset through sub- categorization (Copperman, Figure 17, e.g. identifying groups of query taxonomy tags, marked nodes, and smoothed nodes that are within distance D' from each other);

arranging physical storage locations to reflect said priority based scheme of said plurality of logical partitions and consistently labeling said physical storage locations (Szabo, column 85, line 22, e.g. indexed hard copy);

establishing guidelines for duration of KID storage in electronic and physical UKIDS storage means (Szabo, column 48, lines 32 – 33, e.g. the server may retain search results for a period of time); **and**

naming subset KID storage categories to describe content and context of the KID being stored therein (Copperman, Figure 11, e.g. Employees, engineering, sales, marketing are named in the Taxonomy).

As per Claim 19, and also applied to Claim 1, the combination of Copperman and Szabo teaches:

wherein said rules for purging KID include, at a predetermined time period: separating KID into a first category of KID that is needed,

**a second category of KID that is not needed but retained on hand, and
a third category of KID that is not needed and not retained; purging said
third category; and placing said second category into a long term storage
location** (Szabo, column 48, lines 32 – 33, e.g. the server may retain search results for
a period of time).

As per Claim 22, Claim 22 is recited similar limitations as Claim 1. The
limitations are substantially the same as **Claim 1**; therefore, the rejection of Claim 1 also
applies to Claim 22.

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over
Copperman et al. US 6,711,585 B1 (hereinafter referred as Copperman) in view of
Szabo US 7,181,438 B1 (hereinafter referred as Szabo) and in view of Francis et al. US
PGPub 2003/0101153 A1 (hereinafter referred as Francis).

As per Claim 20, and also applied to Claim 1, the combination of Copperman
and Szabo does not explicitly teach:

**wherein said rules for purging KID include, when an employee leaves a
position, providing a copy of said plurality of personal levels to said employee,
moving said plurality of personal levels to a long term storage location, and
purging said personal levels from said UKIDS.**

On the other hand, Francis teaches:

wherein said rules for purging KID include, when an employee leaves a position, providing a copy of said plurality of personal levels to said employee, moving said plurality of personal levels to a long term storage location, and purging said personal levels from said UKIDS (Francis, paragraph 0162, e.g. as when an employee leaves a company, much of their every day expertise remains behind in notebooks and reports as property of the employer).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Copperman and Szabo to include policy regarding knowledge be retained with the leaving employee in view of Francis. Doing so would provide a means for effectively distinguishing personal knowledge from confidential knowledge relevant to leaving employees.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman et al. US 6,711,585 B1 (hereinafter referred as Copperman) in view of Szabo US 7,181,438 B1 (hereinafter referred as Szabo) and in view Official Notice.

As per Claim 21, and also applied to Claim 1, the combination of Copperman and Szabo teaches:

wherein said rules for sharing and distributing KID include: identifying to a recipient receiver a targeted location for storing distributed KID within one of said plurality of logical partitions; and employing quantity reduction and content quality improvement goals for reducing a volume of distributed KID (Copperman, column 16, lines 6-7, e.g. remove taxonomy tag).

However, the combination of Copperman and Szabo does not teach the limitation of **prior to when an employee leaves a position, having said employee provide their successor employee a tour of said plurality of logical partitions within said UKIDS and identify important KID stored therein;**

Official notice is taken that it was well known in the art at the time of the invention to provide a tour from a current employee to a successor employee to get acquaintance with the location of the data stored in the company.

It would have been obvious to one skilled in the art at the time of invention to combine the teachings of Copperman and Szabo with the noted facts in order to pass along the know-how to the new personnel on the job.

Response to Arguments

11. Applicant's arguments with respect to claims 1 - 22 have been considered but are moot in view of the new ground(s) of rejection.

12. On page 12, section of additional documents, the Applicant files an Affidavit of Michael R. Song under 37 CFR 1.132 on December 4, 2008 and filed on December 10, 2008 to make of record evidence to traverse a rejection of the pending claims under 35 U.S.C. § 103 (a). In particular, the Affidavit presents evidence of secondary consideration including commercial success of the claimed invention, and the long felt need for such a system and evidence that experts in the industry doubt that such a system could be provided (e.g. failures of others).

The Affidavit filed on December 10, 2008 under 37 CFR 1.132 has been considered but is ineffective to overcome rejection under 35 U.S.C. 103 (a). The Examiner submits that the reasons are follows. The Applicant is reminded that the Examiner uses the following to consider the Opinion evidence presented with the Affidavit:

1. the nature of the matter sought to be established,
2. the strength of any opposing evidence,
3. the interest of the expert in the outcome of the case, and
4. the presence or absence of factual support for the expert's opinion. (See. MPEP 716.01(c) III).

(a) On the first page of the filed Affidavit, from points 1 to 3, Mr. Michael Song sets forth that he is one of the inventors of the present application, a CEO of the company, Cohesive Knowledge Solution, Inc of Cuilford, Connecticut, which is the current assignee of the present application, and receives a bachelor of Arts degree in Business Administration from the University of Connecticut in Marketing in 1987.

Although an affidavit of an applicant as to the advantages of his or her claimed invention, while less persuasive than that of a disinterested person, cannot be disregarded for this reason alone. *Ex parte Keyes*, 214 USPQ 579 (Bd. App. 1982); *In re McKenna* 203 F.2d 717, 97 USPQ 348 (CCPA 1953).

The Examiner is hereby noting that the interest of Mr. Song in the outcome of this case is biased. Therefore, a seeking for factual evidence supporting the affidavit is required.

(b) On the first page of the filed Affidavit point 4, Mr. Song swears that a book titled "The Hamster Revolution Revolution", by Mick Song, Vicki, Halsey, and Time Burrell, Berrett-Koehler Publisher, Inc, San Francisco, CA, was provided to the Examiner during the in-person interview. Mr. Song swears that from page 81 to 104, the inventive universal knowledge information and data storage system as recited in claims 1 - 22 of the present application is described. Mr. Song is requesting that the book be considered as part of this Affidavit.

As to the above statement, the Examiner respectfully submits that there is no book titled "The Hamster Revolution Revolution" given to the Examiner during the in-person interview. The book given to the Examiner during the interview on November 13, 2008, is titled "The Hamster Revolution". Further, the Examiner has had indicated that in order to be considered the book as the information to be considered, such information must be submitted on the record according to the Office rules and regulation (see Interview Summary sent out on November 17, 2008).

In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement must be (1) in compliance with the content requirements of 37 CFR 1.98, and (2) filed in accordance with the procedural requirements of 37 CFR 1.97 (emphasis added). (See MPEP 609).

Since the Book titled "The Hamster Revolution Revolution" is never received by the Office, not filed as part the supporting evidence of the Affidavit, nor is filed under 37 CFR 1.97 and 1.98. The Examiner respectfully submits that the book titled "The Hamster Revolution Revolution" and the book given to the Examiner in the prior

interview are not considered as part of this Affidavit until it has been officially filed and formally made of record in accordance with 37 CFR 1.97 and 1.98.

(c) On page 2 of the Affidavit, regarding point a, Mr. Song submits:

there has been a long felt need in business for a system to improve storage and retrieval of information and document such as the universal knowledge information and data storage system recited in Claims 1 -22 of the present application, as is evidenced by pre-training surveys conducted by CKS in 2003. Relevant portion of the pre-training surveys are summarized in document appended to this Affidavit as Exhibit A.

As to the above point, the Examiner submits that establishing long-felt need requires objective evidence that an art recognized problem existed in the art for a long period of time without solution. The problem Mr. Song submits is "improving storage and retrieval of information and document". However, this is not a problem but a desire in the field of the art. Even if we treat such desire as a problem, the long-felt need of the problem has to be measured from the date a problem is identified and efforts are made to solve it. (See MPEP 716.04).

Pages A-1, A-2, and A-3 of Exhibit A provide three slideshow printouts copyrighted in 2008 with a claimed source from 2000 professionals in Info-Excellence Pre-Training Survey. The printouts include eight statements of survey summary of "I'd like to improve my storage system with 95%", "It's often frustrating to locate stored email and documents with 77%", "keeping track of document versions is often challenging with 85%", "I often print documents to make sure I won't lose them with 57%", "The quality of our team shared drive is 'poor' to 'fair' with 65%", "15-35% of the day is spent searching for information", "50% searches are unsuccessful", and "annual cost of lost information is \$5,000 per employee". The data of the page A-1 printout has been identified from a source of 2003, the data of the page A-2 printout is identified from a

source without published year, the data of the page A-3 printout is identified from Portal magazine of June 2003.

The Examiner submits such evidence is ineffective to support the measure of the long-felt need because:

The content of the slideshow printouts only provide the trainees' desires and feelings of improving storage and retrieval of information and document before taking the training. The detailed problems of improving storage and retrieval of information and document are not supported by the evidence.

Furthermore, the copyright of the provided evidence is dated 2008. That is, the evidence supports a date of which a problem is identified in 2008. Even though part of the data contained in the slideshow was identified from 2003, such data is not effectively supporting the long-felt need because the present application claims benefit of January 10, 2003. The evidence does not establish that these data is collected before the domestic benefit. The date of the problem identified thus cannot be established.

Also, no further evidence has provided to support the efforts have been made to solve the identified problem of "improving storage and retrieval of information and document". Therefore, the measure of a long-felt need from the data a problem is identified and effort made to solve it is not established. See MPEP 716.04.

(d) On page 2 of the Affidavit, Mr. Song submits:

b. many industry experts have questioned the desire for having and the ability for one system to effectively order information as is evidence by quotations summarized and appended to this Affidavit as Exhibit B. As such, there currently are no competitive products in the market that include the universal knowledge information and data storage system recited in Claims 1-22 of the present application;

As to the above opinion, the Examiner submits that the quotation of Jon Spira and Information Workers Productivity Council on page B-1 of Exhibit B is ineffective of showing the skepticism of Experts because no date information is provided for Exhibit B. Furthermore, The two quotations in Exhibit B, "it's futile quest to try to order information and knowledge" and "There is no market for PKM (personal knowledge management) products and services because the best categorization schemes, organization systems, and electronic devices are ones that are very personally defined and best suit and individual knowledge work's lifestyle and work habits", are quoted out of context. The quotations have not shown they are directed to the alleged problem that the claimed invention is trying to solve. See MPEP 716.05.

(e) On page 2 of Affidavit, Mr. Song submits:

c. the commercial success of the book and the inventive universal knowledge information and data storage system described therein is demonstrated by the fact that over one hundred thousand (100,000) copies of the book has, since January of 2007, been distributed in 20 countries, in hard copy and paperback, the book has been translated into eleven (11) languages and has resulted in over approximately five hundred thousand dollars (\$500,000 USD) in retail book sales;

d. the industry recognizes the merits of the book and the inventive universal knowledge information and data storage system described therein as is demonstrated by a number of statements from industry experts included in a "Praise for The Hamster Revolution" Section at an unnumbered page 2 of the book, on a back cover of the book, and in a document appended to this Affidavit as Exhibit C; and

e. the commercial success of the book is further evidenced by the fact that The Hamster Revolution is an Amazon.com best-seller. It rapidly rose to number thirty (30) on the Amazon.com business book best-seller list for the first quarter of 2007 which includes thousands of titles, while only slightly over one hundred thousand dollars (\$100,000 USD) was spent publicizing the book.

5. I conduct educational seminars related to knowledge work wherein the features and functions of the inventive universal knowledge information and data storage system as recited in Claims 1-22 of the present application are described and taught to employees of a wide range of corporate entities, which represent about fifteen percent (15%) of The Business Week® Global 1000 Companies including, for example, the General Electric Company, Hewlett Packard, McDonald's Corporation, Mercedes-Benz USA, LLC, and the Schering-Plough Corporation. An exemplary portion of these corporate entities is also provided in a summary page appended to this Affidavit as Exhibit D. Such educational seminars have, since 2003, generated approximately three million dollars (\$3,000,000 USD) in services revenue to CKS. While exact market share figures for email and filing efficiency training are not known, CKS has defined itself as a leader in this market. When considering the COTA component we may already have as much of twenty percent (20%) of the market for training specifically targeted at helping business people reorganize their email

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and documents. Over twenty (20) other companies have contracted with CKS to resell its Info-Excellence® training including the COTA module which is also known as "File and Find It Fast."

As to the above statement, the Examiner submits that gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed.Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988). Mr. Song has stated that the exact market share figures for email and filing efficiency training are not known. As such, statements of the book sales of \$500,000 and giving seminars of training business people in 15% of the Business Week Global 1000 companies do not show commercial success of the claimed invention because of the absence of evidence as to market share.

Furthermore, an applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. The sale of the book or educational seminar is not the same as the sale of the claimed invention. Similarly, the commercial success of training people reorganizing email and documents is not the same as the sales of claimed invention. The book, as Mr. Song pointed out, is directed to the claimed invention from page 84 to 104. The educational seminars, as Mr. Song pointed out, is directed to helping business people reorganize their email and documents but not directed to the claimed invention. The nexus between the claimed invention and evidence of commercial success has not been established.

Also, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). See MPEP 716.03 (b). No such evidence is provided to show that that claimed invention is responsible for the commercial success of the book and the educational seminar.

Last but not least, the objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features, *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), *aff'd*, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed.Cir. 1992). See MPEP 716.03 (a). The sale of a book and educational seminar are not commensurate in scope with the claims.

Therefore, the opinions 4.c – 4.d and 5 are ineffective to show the nonobviousness due to commercial success of the claimed invention.

(f) On page 3, Mr. Song submits that:

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As to the above statement, the Examiner submits that

6. In my opinion, at least one reason for the commercial success of the inventive universal knowledge information and data storage system as recited in independent Claims 1, 16 and 22 of the present application is a direct consequence of superior properties and advantages of the system recited in these claims including, inter alia: a. an interface providing a plurality of logical partitions for segregating and storing knowledge, information and data (KID) in a priority-based and standardized scheme; b. the priority based scheme reflects personal and professional core values of a free enterprise economic system and, thus, is universal as the scheme has applicably in more than one industry; c. the priority based scheme includes personal levels that segregate KID storage into a TEAMS OF PEOPLE subset, an ACTIVITIES subset and an ORGANIZATION AND ADMINISTRATION subset, as well as professional levels that segregate KID storage into a CLIENTS subset, an OUTPUT subset, a TEAMS subset and an ADMINISTRATION subset; d. the standardized scheme includes a clustering of KID to promote transferability between receivers, extensibility across data store platforms (e.g., electronic and physical storage) and scalability in understanding of the KID by providing a plurality of professional scheme models at an enterprise view, a business unit view, a division view, departmental view, team view and an individual view; and e. the interface further providing rules and tools for configuring a data store and for storing and accessing KID included therein.

7. At least one exemplary implementation of the inventive universal knowledge information and data storage system as recited in independent Claims 1, 16 and 22 of the present application is illustrated in a document appended to this Affidavit as Exhibit E, entitled "Turner Construction & COTA®." In my opinion Exhibit E demonstrates a so-called "vertical scalability" of the professional scheme models at the enterprise view (Turner Shared Drive), department view (Departmental Teams) and team view (Jobsite Teams).

8. I believe that the initial and continued commercial success of the inventive universal knowledge information and data storage system as recited in Claims 1-22 of the present application is due to the aforementioned superior properties and advantages not described or disclosed in conventional systems.

9. Based on the foregoing and my years of experience in the industry, it is my opinion that the inventive universal knowledge information and data storage system as recited in Claims 1-22 of the present application is superior to anything previously available to the knowledge worker.

As to the above opinions, the Examiner submits that since Mr. Song is the co-inventor and the CEO of the company which is the assignee of the present application, the opinions made above are of light weight.

Therefore, the Examiner submits that the Affidavit fails to present evidence of secondary consideration including commercial success of the claimed invention, and the long felt need for such a system and evidence that experts in the industry doubt that such a system could be provided to overcome rejection under 35 U.S.C. 103 (a).

Conclusion

13. The prior art made of record:
- a. Copperman et al. US 6,711,585 B1
 - b. Szabo US 7,181,438 B1
 - c. Francis et al. US PGPub 2003/0101153 A1
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- d. Kadoma-shi discloses a group forming system, group forming apparatus, group forming method, program, and medium in EP 1 209599 A2
 - e. Bowman discloses clean up of orphaned server contexts in US Patent No. 6496850.

Contact Information

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VEI-CHUNG LIANG whose telephone number is (571)270-1984. The examiner can normally be reached on Mon.- Fri., 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on (571) 272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 10, 2009

/V. L./

Vei-Chung Liang, Ph.D.

Examiner, Art Unit 2165

/Christian P. Chace/

Supervisory Patent Examiner, Art Unit 2165